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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,526	07/16/2003	Glen A. Morr	614359/82654	8986

7590 11/03/2004

Barnes & Thornburg  
600 One Summit Square  
Fort Wayne, IN 46802

EXAMINER
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LOPEZ, FRANK D

ART UNIT	PAPER NUMBER
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3745

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/620,526

**Applicant(s)**

MORR ET AL.

**Examiner**

F. Daniel Lopez

**Art Unit**

3745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 and 30-38 is/are rejected.
- 7) ☒ Claim(s) 29 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/24/03;3/22/04</u> . | 6) <input type="checkbox"/> Other: ____  |

***Claim Rejections - 35 USC § 112***

Claims 1-18, 21-23 and 25-27 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 line 2-3 "an actuator; at least one piston movable in response to the actuator" is confusing, since the piston is the actuator.

In claim 6 and 21 line 1-2 "a piston is attached to opposed portions of the cable" is wrong, since there are disclosed two pistons, each attached to a respective opposed portions of the cable.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "bearing member" in claims 7, 22 and 23 is used by the claim to mean "spherical member", while the accepted meaning is "support member for a first element movable relative to a second member." The term is indefinite because the specification does not clearly redefine the term. Suggest that --spherical member-- replace "bearing member" in claims 7, 22 and 23 line 2 and in the specification.

Claims not specifically mentioned are indefinite, since they depend from one of the above claims.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18, 20, 21, 25-27, and 30-38 are rejected under 35 U.S.C. § 102(b) as being anticipated by Walters (see discussion below).

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Claims 1, 3, 5, 9, 10, 12-14, 17-19, 24, 30, 37 and 38 are rejected under 35 U.S.C. § 102(b) as being anticipated by Gajek et al. The piston (20) moves a flexible member (25), which moves a pinion (B, fig 3 or 4).

Claims 1, 3-5, 9, 10, 11, 12, 15, 17-19, 24, 28, 30, 37 and 38 are rejected under 35 U.S.C. § 102(b) as being anticipated by Card et al (4,295,630). The piston (35) moves a flexible member (50), which moves a pinion (attached to 14).

Claims 1, 3-5, 7, 9, 10, 11, 12, 15, 17-19, 22-24, 28, 30, 37 and 38 are rejected under 35 U.S.C. § 102(b) as being anticipated by Card et al (4,480,811). The piston (25) moves a flexible member (21), which moves a pinion (18), by way of a ball (26) fitting into a cavity.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1-10, 12-14, 17, 19, 22 and 23 are rejected under 35 U.S.C. § 103 as being unpatentable over Walters in view of Gauthier. Sean discloses a rotary actuator comprising a longitudinally extending flexible member (one of lines 16) having a pair of opposed end, each end being attached to one of two pistons (e.g. 35, 38); a pinion (3, 5 or 7) fixed to the flexible member, wherein linear movement of the piston and flexible member causes rotational movement of the pinion; but does not disclose that the flexible member is attached to the pinion by a fastener (set).

Gauthier teaches, for a rotary actuator comprising a longitudinally extending flexible member (10) fixed to a pinion (12), wherein linear movement of the piston and flexible member causes rotational movement of the pinion; that the flexible member is attached to the pinion by a fastener (38).

Since Walters does not show the details of how the flexible member is attached to the pinion and Gauthier does; it would have been obvious at the time the invention was made to one having ordinary skill in the art to attach the flexible member of Walters to the pinion by a fastener, as taught by Gauthier, as a matter of engineering expediency.

### ***Conclusion***

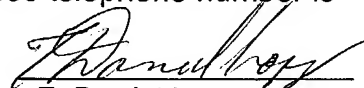
Claims 29 is and are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 16 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. § 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Lopez whose telephone number is (703) 308-0008. The examiner can normally be reached on Monday-Thursday from 6:30 AM -4:00 PM. The examiner can also be reached on alternate Fridays.

I will be moving in November 2004, to the New PTO campus. When I move, my new phone number will be 571- 272-4821.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed Look, can be reached on (703) 308-1044. The fax number for this group is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0861.



F. Daniel Lopez  
Primary Examiner  
Art Unit 3745  
October 29, 2004